

REMARKS

The Examiner rejected Claims 1, 8, 10-12, 18, 21, 23, 25, 31, 34 and 35 under 35 U.S.C. §112, second paragraph, as indefinite given recitation of the term “it” in these claims. Applicant has amended the referenced claims to either delete “it”, or substitute therfor the corresponding object. No new matter has been added. Applicant submits its amendments to the claims obviate the stated grounds for rejection under §112.

Otherwise, the Office Action also raised the following issues:

a) Claims 1, 2 and 5-12 were rejected under 35 U.S.C. Section 102(e) as allegedly anticipated by the disclosure of U.S. Patent No. 6,701,352, issued to Gardner, *et al* (hereafter “Gardner”);

b) Claims 3 and 4 were rejected under 35 U.S.C. Section 103(a) as unpatentable over the disclosure of Gardner, in view of the disclosure in U.S. Patent No. 6,580,914, issued to Smith (hereafter “Smith”); and

c) Claims 13-35 are referenced as “rejected”, according to the rationale provided that these claims “do not teach or define any additional limitation over claims 1-12 and therefore are rejected for similar reasons.” Office Action, page 8.

a) Section 102 Rejection

The Examiner has rejected claims 1,2, 5-12 under 35 U.S.C. §102(e) as being anticipated by Gardner. Applicants respectfully traverse this rejection, for the reasons which follow.

Gardner discloses importation of information stored at a network resource to a local processing resource (Abstract). In the disclosed embodiment, this is performed through a mailing list manager having an import module coupled to a browser (Abstract). Using selection criteria stored at a local processing resource, information is requested from a remote resource and information received from the remote resource is provided to the local processing resource in a usable format (Summary of the Invention). Local processing resources may include an operating system controlling and supervising application software programs installed on a local computer, for instance, on its central processing unit (see Figure 2A). Among the application software programs may be included a communications program, such as a Web browser, and a mailing list manager, and associated databases (see column 6, lines 56-column 7, line 13). Information is retrieved from the web and stored in a format usable by a local processing resources (see column 11, lines 19-22) in memory at files or databases coupled to the particular local processing resource such as the web browser and a mailing list manager (see, for instance, descriptions of web browser functions at column 11, lines 59-65, and column 12, lines 18-26; and descriptions of the mailing list manager at column 12, lines 57-60).

It is well settled that to reject a claim for “anticipation,” the Examiner is required to establish “identity of invention.” *Glaverbel Societe Anonyme v. Northlake Mktg. & Supply*, 33 USPQ2d 1496, 1498 (Fed. Cir. 1995). *Each and every element* recited in a claim must be found in a single prior art reference and arranged as in the claim. *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir 1984). *There must be no differences* between what is claimed and what is disclosed in the applied reference. *In re Kalm*, 154 USPQ 10, 12 (CCPA 1967); *Scripps v.*

Genentech Inc., 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). “Moreover, it is incumbent upon the Examiner to *identify wherein each and every facet* of the claimed invention is disclosed in the applied reference.” *Ex parte Levy*, 17 USPQ2d 1461, 1462 (BPAI 1990). And the Examiner is required to point to the disclosure in the reference “*by page and line*” upon which the claim allegedly reads. *Chiong v. Roland*, 17 USPQ2d 1541, 1543 (BPAI 1990).

Reviewing the elements and limitations of Claim 1, at the very least Gardner fails to disclose remote storage of searched information at a remote site server or any service therefor, or requesting remote site storage from a web server of searched information. Consequently, and again, without reference to any other limitations recited in steps b-f of Claim 1, and insofar as these involve or reference remote site storage, Gardner fails to disclose these steps.

In addition, Gardner also fails to disclose, *inter alia*, allowing: a searcher to send a URL of searched information to a remote site server in which said information is to be stored; setting up a storage path to send a remote storage request to a remote site server; sending a web text to be stored and a URL indicative of a storage location to a remote site server; and allowing storage of said web text in a remote site server if the storage path is valid.

As Gardner fails to disclose elements and limitations of Applicant’s Claim 1, it cannot therefore anticipate this claim, or any claim that is dependent therefrom. As such, the rejection fails also as to dependent claims 2-9 (including as to Claims 3 and 4, rejected based on obviousness over Gardner, in view of Smith, which rejection shall be separately addressed).

With respect to Claims 10-12, Gardner fails also to disclose all elements and limitations of these claims. At the very least, Gardner fails to disclose step d of claim 10, e.g.,

storing searched information in a remote site server along with a set-up transfer path (Applicant, notwithstanding the Examiner's citation to all of columns 11-13 of Gardner. Gardner also fails to disclose step c of Claim 11, i.e., sending searched information by electronic mail to a remote site-server where it is to be stored (again, notwithstanding that the rejection as stated directs Applicant to all of Columns 11-13 for support). And as to Claim 12, Gardner fails to disclose nearly all claimed limitations, including, for instance, a user sending a URL indicative of an uploading location and URL's of a plurality of remote loading servers having shared information (for which limitation, the Examiner provides no citation to Gardner supporting disclosure).

In view of the foregoing, Applicant submits claims 1,2 and 5-12 are patentable, and Gardner fails in its purported role of anticipating any of these claims. Applicant respectfully requests reconsideration and withdrawal of the rejection.

b) Section 103 Rejection

Claims 3 and 4 have been rejected under 35 U.S.C. §103(a) as obvious over the disclosure of Gardner, in view of the disclosure of Smith. Applicants respectfully traverse this rejection, for the reasons which follow.

Gardner has been previously described. In issuing the rejection, the Examiner admits Gardner fails to "explicitly" teach the limitation of accessing a web server using a mobile telecommunication terminal. To bridge the acknowledged gap in Gardner, the Examiner cites Smith for "teaching a method of searching the web" using a mobile telecommunication device. The Examiner then contended that it would have been obvious for one of ordinary skill in the art at the time of the invention to use a mobile communication terminal in Gardner, as taught by

Smith “because doing so would allow the user to access data on the Internet from any geographic location” (see Office Action Page 8).

It is well established that in rejecting claims based on obviousness pursuant to §103, the Examiner must demonstrate that all claimed elements and limitations have been taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974). Putting aside Smith and its asserted disclosure, for now, Gardner demonstrably fails to disclose, teach or suggest all elements and limitations of the claims, for reasons including those presented and discussed with respect to the rejection of Claims 1, 2 and 5-12 under §102. As discussed previously, Gardner simply fails to disclose, *inter alia*, a user directed remote site storage of information retrieved from another remote storage site.

Claims 3 and 4 ultimately depend from Claim 1, and hence incorporate all elements and limitations of the base claim. Consequently, Applicant submits that each element or limitation of its claims 3 and 4, including those necessarily present via dependency on Claim 1 involving said user directed storage, including that of directing such storage using a mobile telecommunication terminal, finds no disclosure, teaching or suggestion in either Gardner or Smith. The asserted combination of Gardner and Smith therefore fails to account for all elements and limitations of Claims 3 and 4. For this reason alone, the rejection of Claims 3 and 4 under §103 should be withdrawn.

In addition, the Examiner also has not cited any specific disclosure, teaching or suggestion in Gardner motivating its asserted combination with the asserted relevant teachings in Smith. In this, the rejection lacks any objective reason or reference to facts supporting the

advanced combination of the cited references, and without such the rejection is clearly insufficient, as a matter of law. *Ex parte Levengood*, 28 USPQ2d 1300 (BPAI 1993). Moreover, it is also well settled that an obviousness rejection must be based on facts, not generalities. *Ex parte Saceman*, 27 USPQ2d 1472 (BPAI 1993). Indeed, “cold hard facts.” *In re Freed*, 165, USPQ 570, 571-72 (CCPA 1970). When a rejection under §103 is not based on facts, it cannot stand. *Ex parte Porter*, 25 USPQ2d 1144, 1147 (BPAI 1992).

Considering these requirements for a *prima facie* case of obviousness, the Examiner’s sole supporting statement, taken without apparent reference to what Applicant’s claim, that combination of Gardner and Smith, “would allow the user to access data on the Internet from any geographic location” is mere speculation as to the desirability, operability, and/or motivation, if any, impelling combination of Gardner with portions of Smith. Therefore, the rejection fails to factually demonstrate any suggestion or motivation for the asserted combination. As the requisite suggestion or motivation cannot be supplied by mere speculation, the rejection of Claims 3 and 4 based on obviousness fails for this reason as well.

Based on the foregoing, reconsideration and allowance of Claims 3 and 4 are respectfully solicited.

c) Rejection of Claims 13-35.

The Examiner has rejected claims 13-35, apparently as supposedly failing to “teach or define any additional limitation over claims 1-12 and therefore rejected for similar reasons” (Office Action, page 8). The rejection is thus recited in an omnibus fashion and without stating for each claim the specific grounds for rejection, or the reasons therefor which are directed to the specific stated elements and limitations they include. This is improper notice to

the Applicant of the rejection, and as such, and given that the rejections of Claims 1-12 are themselves improper, the rejection as to Claims 13-35 should be withdrawn.

At the outset, and as to the contention that Claims 13-35 do not “teach or define any limitation” over Claims 1-12, Applicant registers its vehement disagreement with, and traversal of, this unsupported contention.

In issuing the rejection, the Examiner apparently invites Applicant to construct its own grounds and reasons for rejecting its own claims, and to select same from those grounds and reasons asserted as to Claims 1-12. As Applicant has demonstrated and discussed above, the stated rejections of Claims 1-12 are themselves legally deficient and improper. Thus, the Examiner’s reference to “similar reasons” as those supporting the rejection of Claims 1-12 is clearly insufficient to support rejection of Claims 13-35. Notwithstanding the deficiencies in the stated rejections to Claims 1-12, such a blanket and undifferentiated reference to the status of other claims is manifestly improper, if only because it is unsuitable to guide Applicant in determining relevance or application of this status to other claims.

In rejecting claims, at the very least, the Examiner must state the grounds of each rejection and the reasons therefor. 35 U.S.C. §132(a). If the Examiner cannot meet this requirement, then the claims are deemed allowed. See 35 U.S.C. §1.104 (“The examination shall be complete with respect...to compliance of the application...”). Therefore, it is the Examiner’s burden to demonstrate the unpatentability of any claim(s) by stating the ground of rejection fully and clearly, designating the statutory basis for any ground of rejection by express reference to a section of 35 U.S.C. in the opening sentence of each ground of rejection. M.P.E.P. §707.07(d). In addition, “A plurality of claims should never be grouped together in a common rejection,

unless that rejection is equally applicable to all claims in the group.” §707.07(d), at 700-113 (M.P.E.P. Eighth Ed., 2001, Rev’d 2003). As the MPEP acknowledges, such “omnibus” rejections are “stereotyped” and “not informative”, and should be “avoided.” §707.07(d), at 700-113.

Here, the proffered rejection of Claims 13-35 fails all of the above requirements and should be withdrawn. The mere fact alone that two separate grounds of rejection under 35 U.S.C. (i.e., under §102(e) and §103(a)) were raised with respect to certain of Claims 1-12, makes improper the omnibus and unelaborated rejection of Claims 13-35, as stated. Moreover, as Applicant has demonstrated previously, the reasons stated for rejecting Claims 1-12 demonstrably do not suffice to support the stated rejection of those claims, let alone Claims 13-35. Indeed, withdrawal of the rejection as to Claims 1-12 requires withdrawal of the stated rejection as to Claims 13-35.

Applicant maintains that all claims, including claims 13-35, are patentable as presented, and accordingly requests that these claims be allowed. If the Examining Attorney should continue to reject these claims, notwithstanding Applicant’s traversal, Applicant respectfully demands the Examiner specifically set forth and explain, in a subsequent *non-final* Office Action, the particular legal and factual grounds, if any, for such rejection. Applicant specifically reserves its right to respond and/or comment in further detail if the rejection is maintained and/or is presented with specific grounds and reasons in support.

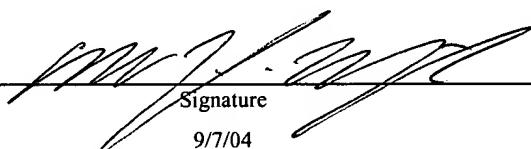
CONCLUSION

For the reasons heretofore discussed, and in view of the amendments provided, favorable consideration and allowance of all claims is respectfully solicited.

Respectfully submitted,

By: 

Charles T. J. Weigell
Reg. No. 43,398
BRYAN CAVE LLP
1290 Avenue of the Americas
New York, N.Y. 10104
(212) 541-1298

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on September 7, 2004
(Date of Deposit)
Charles T. J. Weigell
Name of applicant, assignee, or Registered Representative

Signature
9/7/04
Date of Signature